

REMARKS

This is filed in response to Office Action dated September 25, 2006. Claims 1-11 are pending in the application. Claims 1-8 were rejected and claims 9-11, previously withdrawn from consideration, are hereby canceled. No other amendments are made.

Claims 1-3 and 7-8 stand under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,162,419, to Perricone et al., and claims 1 and 4-8 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 6,162,419 in view of U.S. Patent No. 5,985,951, to Cook. Applicant respectfully traverses these rejections.

Claim 1 of the present application requires a “a composition having a total weight for topical application on a nail comprising: gotu kola and a film former, the gotu kola and film former being dissolved in a solvent that is capable of evaporating to deposit the gotu kola and the film former on to the nail.”

As described in the Background of the present application, gotu kola is known to be used in treating dermal inflammation, for example. While the Perricone patent describes compositions for dermatological and cosmetic use, including compositions containing gotu kola, the Perricone at no point discusses or suggests the use of the compositions with fingernails or as fingernail strengthening treatments. More specifically, Perricone teaches methods and formulae for applying “stabilized ascorbyl compositions,” ascorbyl palmitate, or ascorbic acid to a person. For instance, “compositions of the invention also encompass soaps and other skin cleansing products, deodorants, talcs, liquid dish washing compositions and other household cleaners and products.” Col. 5, lines 13-17. Additionally, some “formulations are useful . . . for hair care products and others for oral hygiene products.” Col. 5, lines 17-18. Lastly, compositions are use for “nontoxic oral vitamin supplements.” Col. 5, lines 19-20. With regards to forming a film of

the composition, this is done, for instance, to “achieve skin tightening and smoothing effects when applied to skin.” Col. 5, lines 35-36.

The Perricone patent fails to teach a treatment or application used for fingernails. Despite the long recitation of the various uses of the compositions, the Perricone patent fails to suggest that finger nails may be strengthened with the compositions.

Furthermore, one would not look to Perricone for such a teaching. Perricone’s teaching of gotu kola is reduced to being included in two separate tables detailing ingredients for a composition. First, the use of gotu kola or its purpose in the composition is not discussed whatsoever in the reference so that there can be no suggestion of it having a benefit for any part of the body, let alone fingernails. It would require the teaching of the present application for one skilled in the art to recognize there is a benefit of gotu kola in a treatment for fingernails, constituting impermissible hindsight. Secondly, the Perricone reference is teaching applications and compositions of ascorbyl palmitate, and there is no teaching or motivation to combine this reference with any other reference to arrive at the claimed invention. Simply stated, one skilled in the art would not look to this reference to arrive at the invention, as claimed, that is a composition for nails and, specifically, for strengthening.

Accordingly, it is believed that this rejection based on anticipation by Perricone should be withdrawn with respect to claim 1, and its dependent claims.

With respect to the combination of Perricone with the Cook patent, it is respectfully submitted that the claims are not made obvious. The Cook patent, while certainly directed towards fingernail coatings, has been examined in detail and has been found to fail in making any mention of gotu kola, or any known variants of gotu kola. In fact, the Office Action fails to allege there is any teaching of gotu kola. The rejection, then, is based on Perricone’s teaching

and purporting that there is a motivation to combine Perricone with Cook's teaching of fingernail polish.

As discussed above, Perricone does not make any mention of treatments for fingernails, nor does it discuss towards what end the gotu kola would be included in the compositions. Perricone does not provide a motivation for using gotu kola in any respect, nor does it provide a motivation for use in a nail treatment. The combination with Perricone and Cook constitutes impermissible hindsight as it requires the teaching of the present application to arrive at the claimed composition including gotu kola.

To be more specific, claim 1 requires gotu kola and a film former, each being dissolved in a solvent capable of evaporating to deposit the gotu kola and the film former on a finger nail. Without addressing what Cook does teach, it certainly does not teach or suggest providing a composition including gotu kola, nor does it teach the gotu kola being part of a composition including a solvent capable of evaporating to deposit on a finger nail. In fact, Cook is directed towards compositions that are ultra-violet (UV) curable, and thus teaches away from compositions that harden by evaporation.

Accordingly, the Office Action bases this rejection on Perricone's teaching of ascorbyl palmitate composition that, incidentally at best, includes gotu kola, and some purported (though absent) motivation to combine this with Cook's teaching of a UV curable composition for fingernails. When viewed properly, it can be seen that Perricone's utility in the combination is reduced simply to an incidental mention of gotu kola in two of approximately fourteen compositions used for cosmetic purposes (such as skin tightening and smoothing), while Cook's teaching is merely describing a fingernail polish. In other words, Perricone's teaching is no more relevant than Applicant's Background that notes the existence of gotu kola for dermal

applications, and Cook's teaching is no more relevant than any reference (or formal notice) that fingernail polish exists.

In short, there is no reference that has been presented which teaches each of the elements of the claim. The combination of references has been made with impermissible hindsight, yet fail to provide a motivation for the combination and still, together, fail to contain each element of the claims (such as a film made by evaporation). Therefore, withdrawal of this rejection is respectfully requested.

In light of the above, Applicants respectfully submit that claims 1-8 are patentable over the art of record because the cited art does not disclose, teach or suggest all the elements of the claimed invention. Accordingly, Applicants respectfully request that claims 1-8 be deemed allowable at this time and that a timely Notice of Allowance be issued in this case.

Should any informal matters remain which can be addressed by an Examiner's Amendment, applicant requests the undersigned be contacted by phone to expedite the prosecution of the present application.

Respectfully Submitted,

SEYFARTH SHAW LLP



Brian S. Clise

Reg. No. 47,497

Attorneys for Assignee

SEYFARTH SHAW LLP
131 S. Dearborn Street,
Suite 2400
Chicago, Illinois 60603-5803
phone: (312) 460-5805
facsimile: (312) 460-7805
customer number: 27717